

REMARKS

The spelling of “feedback” has been corrected in the specification and in claim 1.

Claims 1 and 2 have been rejected under 35 USC 103(a) as being unpatentable over Bausch in view of Rohde and Sano.

Applicant’s invention is a pneumatic servo valve. It controls the flow of a fluid, such as air, into a port so as to control a pneumatic cylinder in accordance with the position of a spool within a chamber through which the fluid flows. The device includes an electromagnetic brake that prevents rotation of a ball nut which forms a part of the spool holding means so as to prevent displacement of the spool due to the flow force of the fluid when the spool is stationary.

Bausch teaches an electric motor-driven positioning element for steering the rear wheels of a car. It is not pneumatic servo valve. It does not control the flow of a fluid. It does not have a chamber within which an axially slidably spool is situated and through which fluid flows.

The examiner comments that the Bausch reference “remains silent” as to what is driven by connection rod 14. However, since the abstract says the device is used for steering the rear wheels of a car, and Figure 1 depicts positioning elements 8, 9 connected to the arms of a semi-trailing arm axle, it is clear that rod 14 drives a mechanical rear steering mechanism and that this reference has nothing to do with a pneumatic servo valve of any kind.

Rohde discloses a fluid power steering system. In Rohde, the screw shaft 39 is connected through a gear tooth structure to the output shaft 42 which in turn is connected to the steering linkage.

The Rohde power steering system is not at all analogous to applicant's pneumatic servo valve nor could it be combined with the Bausch device to obtain a workable machine. Shaft 39 of Rohde could not be connected to rod 14 of Bausch.

Moreover, the combination of these references is inappropriate because there is no teaching, motivation or suggestion in either reference to select and combine the references as the examiner proposes. See In re Lee, 61 USPQ 2d 1430, 1433 (Fed. Cir. 2002) wherein the Court stated:

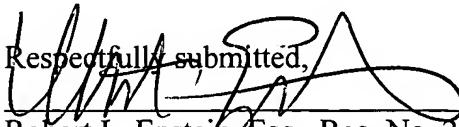
“The factual inquiry whether to combine references must be thorough and searching.” *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120m 1125-25m 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a highlight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so”) (emphasis in original) (quoting *ACS Hosp. Sys. Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d

1350, 1359, 47 USPQ2d 1453m 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); In re *Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

Sano does not add anything to the proposed combination that would achieve a workable machine or provide the motivation to make the combination. Sano may teach a rotary encoder but it teaches the use of same on a steering device such as Rohde’s system. It does not suggest the use of a rotary encoder on a pneumatic servo valve, such as that claimed by applicant.

In short, Bausch does not teach pneumatic servo valve, and even if it did, it could not be connected to Rohde to obtain a workable device. Further, the combination proposed by the examiner is inappropriate because there is no motivation to make same. Even if the combination could be made, it would not result in a workable device and even if it did, the result would not be a pneumatic servo valve with the elements recited by applicant’s claims.

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